

### DETAILED ACTION

Claims 1, 3 and 4 are directed to an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(b), claims 10 and 11, are directed to the process of using the allowable product, previously withdrawn from consideration as a result of a restriction requirement, is hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Because a claimed invention previously withdrawn from consideration under 37 CFR 1.142 has been rejoined, **the restriction requirement of group II as set forth in the Office action mailed on December 9, 2009 is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

### EXAMINER'S STATEMENT OF REASONS FOR ALLOWANCE

Applicant's amendments to the claims and arguments filed February 22, 2010 has been fully considered. In light of the Applicant's amendments, claims 1, 3, 4, 10 and 11 are allowed and renumbered to claims 1-5.

In light of the Applicant's amendments, the previous obvious double patenting rejection over copending Application No. 12/305,356, and 35 U.S.C. 103(a) rejection over Ishida et al. and Torihara et al. is withdrawn.

The following is an examiner's statement of reasons for allowance: The claims 1, 3, 4, 10 and 11 are drawn to a composition comprising one or more compounds selected from 5,7-dihydroxy-3,6-dimethoxy-2-(5-hydroxy-4-methoxyphenyl)-4H-1-benzopyran-4-one, 5,7-dihydroxy-3,6,8-trimethoxy-2-(3,4,5-trihydroxyphenyl)-4H-1-benzopyran-4-one, and 3,5-diethoxy-6,7-dimethoxy-2-(5-ethoxy-4-methoxyphenyl)-4H-1-benzopyrane-4-one in combination with 4-n-butyl resorcinol to whiten or lighten the skin. There is no prior art disclosing the applicant's specific compounds in a composition with n-butyl resorcinol. The closest art is Naganuma et al. (JP 11246339 A). Naganuma et al. teach an external skin composition for skin whitening comprising resorcinol derivatives and an extract from *Achillea millefolium* (Compositae; see abstract). Naganuma et al. does not teach the specific claimed compounds or their amounts. Further, the Applicant's have demonstrated unexpected results with the

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combination of centaureidin (i.e. from 5,7-dihydroxy-3,6-dimethoxy-2-(5-hydroxy-4-methoxyphenyl)-4H-1-benzopyran-4-one) and n-butyl-resorcinol. Particularly, the claimed combination whitens melanoma cells without killing them, whereas n-butyl-resorcinol (a known skin whitener according to Torihara et al. of record) alone whitens cells, but kills them. Therefore the claimed compounds inhibit the cell death activity of n-butyl resorcinol. Thus, it would not be obvious that the specifically claimed compounds in the specifically claimed amounts would provide skin whitening properties with n-butyl-resorcinol without killing the melanoma cells.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kendra D. Carter whose telephone number is (571) 272-9034. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Kendra D Carter/  
Examiner, Art Unit 1627

/SREENI PADMANABHAN/  
Supervisory Patent Examiner, Art Unit 1627